

AMENDMENT AND RESPONSE UNDER 37 CFR §1.116

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Serial No.: 10/000,057

Confirmation No.: 9505

Filed: November 1, 2001

For: ABRASION RESISTANT COATING FOR STACKS OF FIBER CEMENT SIDING

Remarks

The Office Action mailed January 5, 2006, has been received and reviewed. Claims 17 and 52 having been amended, and claim 19 having been canceled, without prejudice, the pending claims are claims 17, 18, 21, and 31-52. Reconsideration and withdrawal of the rejections are respectfully requested.

Interview Summary Record

Applicants' Representative, Ann M. Mueeting, thanks the Examiner for the courtesy extended in the telephonic interview on March 28, 2006. During the interview the amendments presented herein, were discussed.

The 35 U.S.C. §103 Rejections

Claims 17-18, 31-32, and 42-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902); claims 51-52 were rejected as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), as applied to claims 17-18, 31-32, and 42-50 above, and further in view of the applicant's admitted prior art; claims 33-41 were rejected as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), as applied to claims 17-18, 31-32, and 42-50 above, and further in view of Takahashi (U.S. Patent No. 6,103,352); and claims 19 and 21 were rejected as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), and Takahashi (U.S. Patent No. 6,103,352) as applied to claims 33-41 above, and further in view of Harper et al. U.S. Patent No. 4,637,860). These rejections are respectfully traversed.

Claims 17 and 52 have been amended to incorporate the language of claim 19. It is respectfully submitted that there is no teaching or suggestion in any of the cited art, in any combination, of the recited methods of making a siding product that includes a fiber cement

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substrate having a density of at least 1g/cm² and includes wood pulp, silica, and cement, and that has a polyurethane topcoat layer with a dry thickness of at least 8 microns.

Applicants continue to submit that the Examiner has engaged in the impermissible hindsight reconstruction of the claimed invention. Applicants respectfully submit that the Examiner's reasoning is incomplete. As recently asserted in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.* 411 F.3d 1332, 75 U.S.P.Q.2d 1051 (Fed. Cir. 2005), 35 U.S.C. §103 specifically requires an assessment of the claimed invention "as a whole." The "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the cited references and combined them in the claimed manner. In other words, 35 U.S.C. §103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

This "as a whole" instruction in 35 U.S.C. §103 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of the invention. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d 1686, 1690 (Fed. Cir. 2004). Simply identifying the various elements of a claim in the cited reference does not render a claim obvious. *Ruiz*, 357 F.3d at 1275. Instead, 35 U.S.C. §103 requires some suggestion or motivation in the prior art to make the new combination. *In re Rouffet*, 149 F.3d at 1355-56. Applicants submit that the Examiner has engaged in an improper part by part analysis of the claimed invention. In particular, as an

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example only, Applicants submit that the requisite motivation to combine the teachings of four documents in the previous rejection of claims 19 and 21 is lacking.

Summary

It is respectfully submitted that the pending claims 17-19, 21, and 31-52 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4 day of April, 2006, at 2:05pm (Central Time).

By:

Sandy Truhart

Name:

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